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EXAMINER

BENGZON, GREG C

ART UNIT

PAPER NUMBER

2144

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,931

Applicant(s)

UNIACKE, MARK J.

Examiner

Greg Bengzon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This application has been examined. Claims 1-14, 18-21 are pending. Claims 15-17 have been cancelled.

Priority

The effective date of the subject matter in the claims in this application is January 18,2002.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14, 18-21 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-14, 18-21 of copending Application No. 10/032413.

This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14, 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taghadoss (US Patent 6052722) in view of Boer et al. (US Patent 5793765), hereinafter referred to as Boer .

With respect to Claim 1, Taghadoss discloses a method of managing a communication network comprising a plurality of ports, modelled according to a layer protocol, (Taghadoss - Figures 1-2) , and a network management system, the communication network being partitioned into a plurality of subnetworks. (Taghadoss - Column 1 Lines 35-65, Column 2 Lines 40-65)

With respect to Claim 1, Taghadoss does not disclose the method comprising of generating, in respect of a said subnetwork, an off-network pointer exiting the subnetwork at one of said ports, whereby to establish a traffic carrying capability externally to the subnetwork.

Boer discloses a method for determining access points between subnetworks in a digital communications network. The network is partitioned into (abstractions of) subnetworks, with the status, in particular the transport capacity on a link to an adjacent network, of each subnetwork being indicated at so-called access points. (Figures 1-2) At these access points, properties of the network are grouped, i.e. network elements and their properties are represented in a functionally combined way at a higher abstraction level. By means of the combined representation of network elements it is possible to determine a suitable link in a simple manner, without the need of using, in selecting the link, detailed information relating to the individual network elements. As a result, a substantial simplification in the control can be achieved. The repeated partitioning provides a substantially recursive procedure which expediently provides for a simplified

determination of sublinks. Boer discloses generating, in respect of a said subnetwork, an off-network pointer exiting the subnetwork at one of said ports, whereby to establish a traffic carrying capability externally to the subnetwork, said generation performed by software in the system. (Boer - Column 2 Lines 30-65) Boer discloses that the pointer is first generated in one of said layers and functionality at other layers is generated in response thereto. (Boer - Column 3 Lines 20-45, Column 5 Lines 25-65) Boer disclosed determining those ports that represent valid termination points for trails, links and link connections in the subnetworks, whereby to generate trails interconnecting said connection termination points in different subnetworks. (Boer - Column 2 Lines 30-65, Column 8 Lines 30-65)

Taghadoss and Boer are analogous art because they present concepts and practices regarding management of digital communication networks. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the teachings of Boer regarding access points between networks into the method and system of Taghadoss. The combination of Boer into Taghadoss would enable the system of Taghadoss to 1) generate, in respect of a said subnetwork, an off-network pointer exiting the subnetwork at one of said ports, whereby to establish a traffic carrying capability externally to the subnetwork, and 2) determine those ports that represent valid termination points for trails, links and link connections in the subnetworks, whereby to generate trails interconnecting said connection termination points in different subnetworks. The motivation for doing so would be, as Boer

suggests, to allow for a network having central control to be coupled to a network having a distribute control. Selecting links in networks having a central control requires a type of control information which is different from that for networks having distributed control. The combination of Boer and Taghadoss offers the possibility of said networks to cooperate efficiently. (Boer - Column 9 Lines 45-50) Furthermore, the combination allows the access points to interrogate the respective subnetworks for the available transport capacity. (Boer - Column 10 Lines 45-60)

The combination of Taghadoss and Boer disclosed Claim 2 - a method according to Claim 1, wherein the pointer is first generated in one of said layers and functionality at other layers is generated in response thereto. (Boer - Column 3 Lines 20-45, Column 5 Lines 25-65)

The combination of Taghadoss and Boer disclosed Claim 3 - a method according to Claim 1, wherein the generation of said off-network pointer is performed by software. (Boer - Column 4 Lines 60-65)

The combination of Taghadoss and Boer disclosed Claim 4 - a method according to Claim 1, further comprising identifying incomplete trails within a said partition. (Taghadoss - Column 1 Lines 60-65, Column 4 Lines 35-65, Column 6 Lines 40-65)

The combination of Taghadoss and Boer disclosed Claim 5 - a method of managing a communication network comprising a plurality of ports, (Figures 1-2)

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modelled according to a layer protocol, and a network management system, the communication network being partitioned into a plurality of subnetworks, (Taghadoss - Column 1 Lines 35-65, Column 2 Lines 40-65) the method comprising determining those ports that represent valid termination points for trails, links and link connections in the subnetworks, whereby to generate trails interconnecting said connection termination points in different subnetworks. (Boer - Column 2 Lines 30-65, Column 8 Lines 30-65)

The combination of Taghadoss and Boer disclosed Claim 6, Taghadoss does not disclose a method according to Claim 5, wherein the valid termination points for trails, links and link connections are first generated in one of said layers and functionality at other layers is generated in response thereto. (Boer - Column 2 Lines 30-65, Column 8 Lines 30-65)

The combination of Taghadoss and Boer disclosed Claim 7 - a method according to Claim 5, wherein the generation of said valid termination points is performed by software. (Boer - Column 2 Lines 30-65, Column 8 Lines 30-65)

The combination of Taghadoss and Boer disclosed Claim 8, Taghadoss discloses a method according to Claim 5, further comprising identifying incomplete trails

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within a said partition. (Taghadoss - Column 1 Lines 60-65, Column 4 Lines 35-65, Column 6 Lines 40-65)

With respect to Claims 9, the Applicant describes a network with the same limitations as Claim 1. Claim 9 is rejected on the same basis as Claim 1.

With respect to Claim 10, the Applicant describes a network with the same limitations as Claim 5. Claim 10 is rejected on the same basis as Claim 5.

With respect to Claim 11, the Applicant describes a network management system with the same limitations as Claim 1. Claim 11 is rejected on the same basis as Claim 1.

With respect to Claim 12, the Applicant describes a network management system with the same limitations as Claim 5. Claim 12 is rejected on the same basis as Claim 5.

With respect to Claims 13, the Applicant describes a carrier carrying software for the method of Claim 1. Claim 13 is rejected on the same basis as Claim 1.

With respect to Claims 14, the Applicant describes a carrier carrying software for the method of Claim 5. Claim 14 is rejected on the same basis as Claim 5.

With respect to Claims 18-21, the Applicant describes a user interface with the same limitations as Claims 1, 5, 11, 12. Claims 18-21 are rejected on the same basis as Claims 1, 5, 11, 12.

Response to Arguments

Applicant's arguments filed 07/21/2005 have been fully considered but they are not persuasive.

The Examiner's objections to the Drawings are withdrawn.

The rejections based on 35 USC 112 1st Paragraph are withdrawn.

The Applicant presents the following argument(s) [*in italics*]:

The access point is not a pointer exiting the subnetwork as claimed. As is explained at page 17 of the present application: "From information about off-network connectivity at the physical or logical layers, the invention enables logical functionality to be extrapolated up to the point where a "logical pipe" extends across the region to another operator's region, enabling a service to be built across to the other region. The point is ultimately reached where services are offered that can in turn offer services.

The Examiner respectfully disagrees with the Applicant. In Column 4 Lines 50-60 Boer describes the access points as representative of a partitioned network upon which other access points from adjacent networks may be linked. Thus the access points described by Boer and links formed between access points represent the 'logical pipe' from one region of control to another region. The access points are also indicative of the network elements that are contained in the subnetwork in question, (Boer - Column 7 Lines 40-45) said access point leading to adjacent networks for traffic from said network elements. (Boer - Column 5 Lines 45-50, Column 8 Lines 10-20) Thus said access point act as off-network pointers for said network elements.

The Applicant presents the following argument(s) *[in italics]*:

In contrast, Boer seems not to limit which ports can be used for links between partitions, so there can be no disclosure of determining which ports represent valid termination points for trails in the subnetworks, as claimed. An access point is simply assigned in Boer in each subnetwork, without any step of first determining which ports are valid termination points for such links between different subnetworks, as claimed.

The Examiner respectfully disagrees with the Applicant. The access points are indicative of the network elements that are contained in the subnetwork in question, (Boer - Column 7 Lines 40-45) said access point leading to other access points. In Figures 1 and 2 Boer indicates said access points to be on the demarcation line of the subnetworks, hence the access points must be considered edge points in the subnetwork. Since Boer assigns the access points as part of determining a suitable link between subnetworks, (Boer - Column 7 Lines 40-45, Column 10 Lines 35-40) the said access points must be determined to be valid termination points for such links between different subnetworks. At any rate, since Taghadoss also disclosed a method for determining valid termination points for establishing a logical pipe (Taghadoss – Column 10 Lines 20-35), the combination of Taghadoss and Boer disclosed determining valid termination points for links between different subnetworks.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Bengzon whose telephone number is (571) 272-3944. The examiner can normally be reached on Mon. thru Fri. 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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